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Paper 12

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**OFFICE OF PETITIONS**

In re Application of  
Theoharides  
Application No. 09/771,669  
Filed: 30 January, 2001  
Attorney Docket No. 51275/107

: DECISION ON PETITION

This is the decision on the renewed petition filed 7 January, 2003, to revive the above-identified application under 37 C.F.R. §1.137(a).<sup>1</sup>

The petition under 37 C.F.R. §1.137(a) is **GRANTED**.

**BACKGROUND**

The record indicates that:

- the application became abandoned for failure to reply timely and properly to non-final Office action mailed on 27 March, 2002, and due (absent extension of time) on or before 27 June, 2002;
- in a statement incorporated into and documentation accompanying the original petition filed 18 November, 2002, Petitioner alleged that the reply was timely filed, but apparently misplaced in the Office, however, Petitioner failed to supply a copy of said reply

<sup>1</sup> A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee required by 37 C.F.R. §1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(e).

(notwithstanding the statement in the petition that said reply accompanied the petition) or the receipt card Petitioner alleged was date-stamped by the Office;

- therefore the 18 November, 2002, petition was dismissed on 24 December, 2002;
- Petitioner filed with the instant renewed petition a copy of the reply alleged to have been filed on 15 May, 2002, following the 27 March, 2002, non-final Office action.

CONCLUSION

Therefore , the petition to revive under 37 C.F.R. §1.137(a) hereby is **granted**.

This application is being forwarded to Technology Center 1600 for further processing.

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions



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Paper 9

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**DEC 24 2002**

**OFFICE OF PETITIONS**

In re Application of  
Theoharides :  
Application No. 09/771,669 : DECISION ON PETITION  
Filed: 30 January, 2001 :  
Attorney Docket No. 51275/107 :

This is the decision on the petition filed 18 November, 2002, to revive the above-identified application under 37 C.F.R. §1.137(a).<sup>1</sup>

The petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

**NOTES:**

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b)<sup>2</sup> (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted.

The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";

<sup>1</sup> A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) the petition fee required by 37 C.F.R. §1.17(l);

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

<sup>2</sup> Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

(2) Thereafter, there will be no further reconsideration of this matter.

### BACKGROUND

The record indicates that:

- the application became abandoned for failure to reply timely and properly to non-final Office action mailed on 27 March, 2002, and due (absent extension of time) on or before 27 June, 2002;
- through his statement and supporting documentation,<sup>3</sup> Petitioner alleges that the reply was timely filed, but apparently misplaced in the Office, however, Petitioner fails to supply a copy of said reply (notwithstanding the statement in the petition that said reply accompanied the petition).

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>4</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>5</sup>

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<sup>3</sup> In a telephone conversation with the Office on Monday, 16 December, 2002, Petitioner agreed to supply via FAX ((703) 308-6916) additional documentation to the Office. As of this writing, this material has not been received.

<sup>4</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>5</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.<sup>6</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>7</sup> And the Petitioner must be diligent in attending to the matter.<sup>8</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>9</sup>))

Allegations as to the Petition  
Alleging Unavoidable Delay

A delay is not "unavoidable" when an applicant apparently simply permits the maximum extendable statutory period for reply to expire.<sup>10</sup> In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.<sup>11</sup> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>12</sup>

Petitioner has failed to support the allegation and has failed to provide the requisite reply.

Accordingly, in view of the failure of the Petitioner to satisfy the "showing" and "reply" requirements herein, the petition to revive as to unavoidable delay under 37 C.F.R. §1.137(a) must be and hereby is dismissed.

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<sup>6</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>7</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>8</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>9</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>10</sup> See MPEP 711.03(c)(III)(C)(2).

<sup>11</sup> *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>12</sup> *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

ALTERNATIVE VENUE

If Petitioner is unable to make a showing of unavoidable delay surpassing that tendered heretofore, Petitioner's only alternative to irretrievable abandonment is to file a petition and fee as set forth at NOTE 1, above at page 2, under 37 C.F.R. §1.137(b), and state therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional," and submit therewith the requisite "reply."

Thus, Petitioner may wish to supplement his petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the "showing" burden is much less onerous.

Further correspondence with respect to this matter should be addressed as follows:

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Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

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